

### **REMARKS/ARGUMENTS**

Claims 1, 2, 5-8, 10-16, 27, 28, 30 and 31 are pending in this application. All of these claims have been rejected.

Claim 1, which is the only independent claim pending in this application, has been amended to clarify that the PVD aluminum pigment is a required component of the claimed nail varnish. It should now be clear from the amended language that the “at least one of” language in the subject claim reads only on the “plasticizer and dispersing agent”. Furthermore, the claim is also modified to recite that the pigment component of the claimed nail varnish has a low or non-existent tendency toward agglomeration within the nail varnish. This latter amendment is believed fully supported by the disclosure contained in paragraph [0063] of the publication of the present application, i.e., US 2007/0207099 A1 (pub. date September 6, 2007).

Entry of the claim amendments and reconsideration of the application is respectfully requested.

### **Claim Rejections Under 35 U.S.C. §103**

In ¶5 on p. 3 of the Office Action, claims 1, 2, 6, 8, 11-14, 16, 27, 28, 30 and 31 are rejected under 35U.S.C. §103(a) as allegedly unpatentable over USP 6,296,839 to Ramin et al. in view of USP 6,624,076 Miekka et al. This rejection is respectfully traversed.

Applicants submit that the Ramin et al. reference describes a fluid nail varnish composition that produces, after application, a very chased appearance that is highly visible to the eye (see, e.g., col. 1, lines 60-63 of Ramin et al.). The chased appearance is produced by an aggregation of metal pigments at the surface of the film (see Ramin et al., col. 1 lines 35-38).

In contrast to Ramin et al., however, the claims of the present application are directed to a composition (i.e., a nail varnish) that, when applied, produces a multicolored iridescence, as well as a lustrous metallic effect giving the impression of being a preferably cohesive metallic layer. As one of ordinary skill would immediately recognize, the appearance of such a cohesive metallic layer is completely different from the chased appearance described for the composition taught in Ramin et al., i.e., wherein as noted above the chased appearance is attributable to an aggregation of metal pigments at the surface of the film, which aggregation, as explained in further detail below, does not occur in the composition as presently claimed.

Contrasting the presently claimed nail varnish composition with the disclosure contained in Ramin et al., applicants note that their specification teaches that the claimed nail varnish constitutes a metallic film which is uniform in appearance and has a colored iridescence. As one having an ordinary level of skill in the relevant art would know, in order to produce this intended effect (i.e., uniformity of appearance and a colored iridescence), agglomeration of the pigment contained in the nail varnish must be avoided. The avoidance of agglomeration, i.e., in the presently claimed composition, would be immediately apparent from teaching(s) such as that contained in paragraph [0029] of the publication of applicants' application, which states:

*"Consequently, the invention relates to a cosmetic composition that, after application, produces a coating comprising a metallic film which is preferably uniform in appearance and has a colored iridescence. The appearance can also be described as a rainbow color effect."*

Since, as pointed out above the above-described features of the presently claimed composition cannot be obtained if the pigment is agglomerated, applicants teach in their application that the claimed composition must have a "low or even non-existent" tendency toward agglomeration (see para. [0063] of the publication of the present application). This feature, then, which as indicated above clearly serves to distinguish the presently claimed composition from that described in Ramin et al., and which is entirely supported by the teaching set forth in paragraph [0063] of the present application, has thus now been inserted by amendment into claim 1. One having at least an ordinary level of skill in the relevant art would clearly be capable of recognizing when a pigment has such a low or even non-existent tendency toward agglomeration since, as noted above, the effects produced by the presently claimed nail varnish, i.e., uniformity of appearance and a colored iridescence, are impossible to achieve without such a lack of agglomeration.

Further on the subject of non-agglomeration, applicants respectfully submit that an artisan of ordinary skill in this field would recognize that the non-agglomeration of the embossed pigments utilized in the presently claimed nail varnish is due to the specific structure of the pigments themselves. As explained in regard to the discussion concerning Fig. 2 as provided with the present application, the embossment of the pigments (i.e., those contained in the subject nail varnish) minimizes the contact area between the pigments and this, in turn, leads to a

surprisingly low, or even non-existent tendency toward agglomeration that, as indicated above, is a requirement for producing the desired visual effects.

The basis for the lack of agglomeration observed in regard to the pigments contained in the presently claimed composition is further described in paragraphs [0060] – [0064] contained in the publication of the present application. As taught therein:

[0060] *"Fig. 2 illustrates schematically what is meant by a 'peak to valley' and a 'peak to peak' alignment, respectively."*

[0061] *"The spacing between the embossed aluminum pigments is very small in a 'peak to valley' alignment. The contact surfaces and consequently the forces of attraction between the embossed aluminum pigments might be very large in this case."*

[0062] *"The spacing between the aluminum pigments is greatest in a 'peak to peak' alignment, wherein the contact surfaces or contact points are consequently minimal. The risk of agglomeration is considerably reduced in this alignment of the embossed aluminum pigments."*

[0063] *"It has been found in the present invention that the agglomeration tendency in the cosmetic composition, preferably a nail varnish or a lip gloss is surprisingly low or even non-existent."*

[0064] *"The person skilled in the art would expect the aluminum pigments to agglomerate in a medium of increased viscosity, as is indeed the case with smooth, unembossed PVD aluminum pigments, such as Metalure® (marketed by Eckart of Fuerth, Germany)."*

Thus, as taught in paragraph [0064] (quoted above) the embossed pigments used in the presently claimed nail varnish formulation do not show a tendency to agglomerate, which is contrary to the unembossed PVD aluminum pigments, such as Metalure®, which pigments are those used in accordance with the disclosure provided in Ramin et al. (see col. 3, lines 54-57).

As may be seen from the discussion above, it is no simple matter (and thus it is not obvious) to substitute one "form" or "type" of pigment for another. Further evidence of this is

provided by the fact that, were the pigments claimed for use in the present invention to be incorporated in the nail varnish described in Ramin et al., the pigments would likewise agglomerate due to the specific composition of the lacquer system described in the subject reference. That is, the chased effect exhibited by the formulation disclosed in Ramin et al. is specifically attributable to the use of the specific pyrogenic silica and the respective organopolysiloxanes taught for use in Ramin et al. In contrast, however, as taught for example in the paragraph bridging pp. 5 and 6 of the present specification, applicants' claimed nail varnish, following its application, produces a coating comprising a metallic film that is preferably uniform in appearance and that has a colored iridescence. However, if one were to substitute the pigments used in the present invention in the formulation according to Ramin et al., one having at least an ordinary level of skill in the relevant art would recognize that it would not be possible to obtain such a coating of a metallic film which is uniform in appearance and that has a colored iridescence, i.e., because the pigments would agglomerate, as noted above.

Applicants recognize, of course, that the rejection of their claims is based not on Ramin et al. alone, but on what would be suggested to one having at least an ordinary level of skill in this art by the combination of Ramin et al. with Miekka et al. Miekka et al. is cited, as indicated in the portion of the Office Action bridging pp. 4-5, due to its disclosure regarding embossed metallic pigments. The Examiner then concludes, based on combining the disclosure of Miekka et al. with that of Ramin et al., that it would have been "obvious" to one having an ordinary level of skill at the time the presently claimed nail varnish was developed to produce the composition of Ramin et al. and to substitute the aluminum pigments taught for use therein with the embossed pigments disclosed in Miekka et al. Applicants most respectfully disagree very strongly with the above-indicated conclusion. Taking into account that the object of Ramin et al. is to produce a fluid nail varnish with a very chased appearance highly visible to the eye, which effect, as noted above, requires the pigments to be highly agglomerated, a skilled artisan in this field would not find it obvious to replace the unembossed pigments necessary to such agglomeration, with the embossed pigments of Miekka et al., since the embossed pigments would lead to little or no agglomeration (see the discussion above) and thus fail to lead to the highly chased appearance so desirable according to Ramin et al.

Thus, for all of the reasons set forth above, the Examiner is respectfully requested to reconsider and withdraw the rejection of claims 1, 2, 6, 8, 11-14, 16, 27, 28, 30 and 31 based on the combination of Ramin et al. and Miekka et al.

Further to the above, in ¶6 on p. 9, claims 5 and 7 are rejected under 35 U.S.C. §135(a) as being allegedly unpatentable over Ramin et al. in view of Miekka et al. and further in view of United States Pre-Grant Application Publication No. 2004/0071644 A1 to Mougin et al. This rejection is respectfully traversed.

Claims 5 and 7 are written in dependent form, i.e., both depending upon claim 1. As such, the two rejected claims each contain all of the features recited in claim 1. As indicated above (which discussion is expressly incorporated herein) claim 1 is readily distinguishable over the combination of Ramin et al. and Miekka et al. and, thus, claims 5 and 7 are believed to distinguish over these references for essentially the same reasons. Furthermore, the additional combination of the disclosure contained in Mougin et al. with that of Ramin et al. + Miekka et al., fails to teach or even suggest what is presently claimed. That is, Mougin et al. is cited due to its teaching in regard to a nail varnish composition containing at least one film-forming polymer, such as cellulose nitrate, having a number average molecular weight of less than or equal to 300,000. Even taking this characterization at face value, however, the disclosure of Mougin et al., taken together with the combination of Ramin et al. and Miekka et al., would neither teach nor even suggest to produce a formulation according to Ramin et al. and to substitute therein the embossed pigments described in Miekka et al., i.e., for the reasons previously set forth.

For all of the reasons set forth above, therefore, the Examiner is respectfully requested to reconsider and withdraw the rejection under §103 of claims 5 and 7.

In ¶7 on p. 11, claim 10 is rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Ramin et al. in view of Miekka et al. and further in view of USP 5,326,796 to LeCacheur et al. The rejection also is respectfully traversed.

In like manner to the rejection of claims 5 and 7 that are discussed above, claim 10 is dependent upon claim 1 and thus it contains all of the features recited in the subject independent claim. As claim 1 is believed to distinguish over Ramin et al. and Miekka et al. for the reasons set forth above, which discussion is expressly incorporated herein, claim 10 is believed to be distinguishable thereover for the same reasons. Nor does the combination of LeCacheur et al. with Ramin et al. and Miekka et al. remedy the deficiencies exhibited by the combination of

Ramin et al. and Miekka et al. That is, as indicated on p. 11 of the Office Action the LaCacheur et al. reference is cited due to its teachings regarding plasticizer and their function in a nail varnish. However, even granting that LaCacheur et al. does contain such indicated disclosure, this disclosure still would not suggest to one skilled in this field of art to replace the unembossed pigments taught in Ramin with the embossed pigments described for use in Miekka et al. since, to do so, would entirely frustrate the purpose of the Ramin reference, i.e., the production of a nail varnish composition producing, after its application, a very chased appearance highly visible to the viewer's eye – which chased appearance is due to an agglomeration of the (unembossed) pigments at the surface of the film.

For the reasons presented herein, therefore, the Examiner is respectfully requested to reconsider and withdraw the §103 rejection of claim 10.

In ¶8 on p. 12, claim 15 is rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Ramin et al. in view of Miekka et al. and further in view of Seubert, "PVD Aluminum Pigments: Superior Brilliance for Coatings and Graphic Arts". The rejection is respectfully traversed.

Again, as in the discussion(s) above regarding the rejection of claims 5, 7 and 10, applicants note that claim 15 is dependent upon claim 1 and thus it includes all of the features recited by that independent claim. Thus claim 15 is believed to be distinguishable over Ramin et al. + Miekka et al. for the same reasons as claim 1 (the discussion above regarding that claim are expressly incorporated by reference herein). Furthermore, Seubert is cited (see the Office Action at p. 12) due to its disclosure that a diffractive structure may constitute a reflection grating. Even taking this characterization of Seubert at face value, however, the combination of that reference with Ramin et al. and Miekka et al. brings one no closer to applicants' claimed nail varnish since Seubert contains no disclosure that would teach or suggest the substitution of pigments as postulated by the Examiner (see p. 5 of the Office Action), i.e., involving the use of the embossed pigments described in Miekka et al. for those taught for use by Ramin et al. The reason(s) why such a substitution would not be obvious to an artisan having an ordinary level of skill in this field is/are set forth in detail above.

For all the reasons set forth above, the Examiner is respectfully requested to reconsider and withdraw the rejection of claim 15.

Further to the above, in ¶9 on p. 13 of the Office Action, the Examiner cites several references which are considered “relevant” by him but which are not applied in any of the present rejections. Applicants’ U.S. representative has been advised by their European Counsel that the indicated documents do not disclose metallic effect pigments, let alone embossed PVD aluminum pigments and that the additional references are directed generally to “nail varnishes”. However, applicants respectfully submit that they are not claiming a “generic” nail varnish, but rather a very specific composition having all of the features recited in, e.g., claim 1 which features are believed not to be taught or suggested by the prior art.

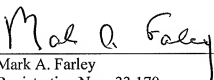
### Summary

Applicants respectfully submit that the amendments to claim 1, taken together with the remarks presented herein, are believed to distinguish claim 1, as well as the remaining claims that depend from that claim, over all of the art cited and applied in the present Office Action. The Examiner is, therefore, requested to reconsider and withdraw all of the claim rejections and to issue a Notice of Allowance for all of the claims presently pending in this application. If he does not agree, and believes that an interview would advance the progress of this case, he is respectfully invited to telephone applicants’ representative at the number below in order that such an interview may be scheduled.

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Respectfully submitted,

  
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